

## **II. REMARKS**

### **A. Introduction**

The Final Office Action dated March 31, 1998 (Final Office Action) has been carefully reviewed and the foregoing amendments made in response thereto.

Claims 56, 57, 61, 65-67, 69-71, 75, 76, 80, 84, and 89-91 are amended. Claims 56-92 are pending in the application.

Claims 56-92 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 56-74 and 77-79 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 56-74 and 89-91 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Campbell et al., U.S. Patent No. 4,536,791.

Claims 75-79 are rejected under 35 U.S.C. § 102 (b or e) as being anticipated by Hedger ("Broadcast Telesoftware: Experience with ORACLE", 1980).

Claims 80 and 82 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Gimple et al., U.S. Patent No. 4,430,731.

Claims 81, 83 and 92 are rejected under 35 U.S.C. § 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 (a) as being unpatentable over Gimple et al., U.S. Patent No. 4,430,731.

Claims 84-86 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gimple et al., U.S. Patent No. 4,430,731 in view of Millar et al., British Patent Specification 1,370,535.

Claims 87 and 88 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gimple et al., U.S. Patent No. 4,430,731 in view of Millar et al., British Patent Specification 1,370,535 as applied to claims 84-86, and further in view of Lambert, U.S. Patent No. 4,381,522.

Claims 75-79 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Zaboklicki, DE 2904981, in view of "A Public Broadcaster's View of Teletext in the United States" by Hartford Gunn.

Claims 56-92 remain active in this application. No new matter is presented in the foregoing amendments. Approval and entry of same is respectfully requested.

**B. Withdrawal of Previous Requirement**

Applicants note with appreciation the withdrawal of the rejection of the claims in the present application under double patenting based on the broad analysis of *In re Schneller* as set forth in paragraphs 7-10 of the previous Office Action.

**C. Response to Requirement Imposed Upon Applicants to Resolve Alleged Conflicts Between Applicants' Applications.**

Applicants respectfully traverse the requirements of the Final Office Action paragraph 6.

Paragraph 6 of the Final Office Action requires Applicants to either:

- (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; or
- (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or
- (3) resolve all conflicts between claims in the related 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications.

In addition, Examiner states that failure to comply with any one of these requirements will result in abandonment of the application.

Examiner states that the requirement has been made because conflicts exist between claims of the related co-pending applications, including the present application. Examiner sets forth only the serial numbers of the co-pending applications without an indication of which claims are conflicting. Examiner has also attached an Appendix providing what is deemed to be clear evidence that conflicting claims exist between the 328 related co-pending applications and

the present application. Further, Examiner states that an analysis of all claims in the 328 related co-pending applications would be an extreme burden on the Office requiring millions of claim comparisons.

Applicants respectfully traverse these requirements in that Examiner has both improperly imposed the requirements, and has incorrectly indicated that abandonment will occur upon failure to comply with the requirement. Applicants' traversal is supported by the fact that 37 C.F.R. § 1.78 (b) does not, under the present circumstances, provide Examiner with authority to require Applicants to either: 1) file terminal disclaimers; 2) file an affidavit; or 3) resolve all apparent conflicts. Additionally, the penalty of abandonment of the instant application for failure to comply with the aforementioned requirement is improper for being outside the legitimate authority to impose abandonment upon an application. The following remarks in Section (C) will explain Applicants' basis for this traversal.

**1. The PTO's New Requirement is an Unlawfully  
Promulgated Substantive Rule Outside the  
Commissioner's Statutory Grant of Power**

The PTO Commissioner obtains his statutory rulemaking authority from the Congress through the provisions of Title 35 of the United States Code. The broadest grant of rulemaking authority -- 35 U.S.C. § 6 (a) -- permits the Commissioner to promulgate regulations directed only to "the conduct of proceedings in the [PTO]". This provision does NOT grant the Commissioner authority to issue substantive rules of patent law. *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).<sup>1</sup> Applicants respectfully submit that the Examiner's creation of a new set of requirements based upon 37 C.F.R. § 1.78(b) constitutes an unlawful promulgation of a substantive rule in direct contradiction of a long-established statutory and regulatory scheme.

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<sup>1</sup> Accord *Hoechst Aktiengesellschaft v. Quigg*, 917 F.2d 522, 526, 16 USPQ2d 1549, 1552 (Fed. Cir. 1990); *Glaxo Operations UK Ltd. v. Quigg*, 894 F.2d 392, 398-99, 13 USPQ2d 1628, 1632-33 (Fed. Cir. 1990); *Ethicon Inc. v. Quigg*, 849 F.2d 1422, 1425, 7 USPQ2d 1152, 1154 (Fed. Cir. 1988).

## 2. The PTO's Requirement is a Substantive Rule

The first determination is whether the requirement as imposed by the PTO upon Applicants is substantive or a procedural rule. The Administrative Procedure Act offers general guidelines under which all administrative agencies must operate. A fundamental premise of administrative law is that administrative agencies must act solely within their statutory grant of power. *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). The PTO Commissioner has NOT been granted power to promulgate substantive rules of patent law. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1686 (Fed. Cir. 1991).

The appropriate test for such a determination is an assessment of the rule's impact on the Applicants' rights and interests under the patent laws. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1215 (D.D.C. 1995). As the PTO Commissioner has no power to promulgate substantive rules, the Commissioner receives no deference in his interpretation of the statutes and laws that give rise to the instant requirement. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996), citing, *Chevron v. Natural Resources Defense Council*, 467 U.S. 837 (1984). When agency rules either (a) depart from existing practice or (b) impact the substantive rights and interests of the effected party, the rule must be considered substantive. *Nat'l Ass'n of Home Health Agencies v. Scheiker*, 690 F.2d 932, 949 (D.C. Cir. 1982), *cert. denied*, 459 U.S. 1205 (1983).

### a. The PTO's Requirement is Substantive Because it Radically Changes Long Existing Patent Practice by Creating a New Requirement Upon Applicants Outside the Scope of 37 C.F.R. § 1.78 (b)

The Examiner's requirement is totally distinguishable from the well articulated requirement authorized by 37 C.F.R. § 1.78 (b), because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the

claims. Long existing patent practice recognizes only two types of double patenting, double patenting based on 35 U.S.C. § 101 (statutory double patenting) and double patenting analogous to 35 U.S.C. § 103 (the well-known obviousness type double patenting).<sup>2</sup> These two well established types of double patenting use an objective standard to determine when they are appropriate<sup>3</sup> and have a determinable result on the allowability of the pending claims.

The Examiner's new requirement represents a radical departure from long existing patent practice relevant to conflicting claims between co-pending applications of the same inventive entity. Two well established double patenting standards are based on an objective analysis of comparing pending and *allowed* claims. However, in the present application, there are no *allowed* claims. The Examiner's new requirement to avoid a double patenting rejection presumes that conflicts exist between claims in the present application and claims in the 327 copending applications. This presumption of conflicts between claims represents a radical departure from long existing patent practice as defined by 37 C.F.R. § 1.78 (b), which states:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

Clearly, the only requirement authorized by the rule is the elimination of conflicting claims from all but one application where conflicting claims have been determined to exist. Furthermore, in order to determine that conflicting claims do in fact exist in multiple applications, the only possible analysis is obviousness-type double patenting, since there are no

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<sup>2</sup>MPEP § 804(B)(1) states, in an admittedly awkward fashion, that the inquiry for obviousness type double patenting is analogous to a rejection under 35 U.S.C. 103: "since the analysis employed in an obvious-type double patenting determination parallels the guidelines for a 35 U.S.C. 103 rejection, the factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis".

<sup>3</sup> The objective test for same invention double patenting is whether one of the claims being compared could be literally infringed without literally infringing the other. The objective test for obviousness type double patenting is the same as the objective nonobviousness requirement of patentability with the difference that the disclosure of the first patent may not be used as prior art.

allowed or issued claims by which to employ the 35 U.S.C. § 101 statutory double patenting analysis. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

In summary, the Examiner's new requirement departs from long-established practice because it (1) creates and imposes a new requirement to avoid abandonment of the application based on the allegation that conflicts exist between claims of the related 328 co-pending applications, and (2) it results in an effective final double patenting rejection without the PTO's affirmative double patenting rejection of the claims.

Therefore, the Examiner's new requirement departs from existing practice and therefore is a **substantive rule** beyond the authority of the PTO and is therefore, invalid.

**b. The New Requirement is Also a Substantive Rule  
Because it Adversely Impacts the Rights and  
Interests of Applicants to Benefits of the Patent**

The rights and benefits of a U.S. patent is solely a statutory right. *Merck & Co., Inc. v. Kessler*, 80 F.3d 1543 (Fed. Cir. 1996). The essential statutory right in a patent is the right to exclude others from making, using and selling the claimed invention during the term of the patent. Courts have recognized that sometimes new procedural rules of the PTO are actually substantive rules, e.g. when the new rule made a substantive difference in the ability of the applicant to claim his discovery. *Fressola v. Manbeck*, 36 USPQ2d 1211, 1214 (D.D.C. 1995) (emphasis added), citing, *In re Pilkington*, 411 F.2d 1345, 1349; 162 USPQ 145 (CCPA 1969); and *In re Steppan*, 394 F.2d 1013, 1019; 156 USPQ 143 (CCPA 1967).

The new requirement, on its face and as applied here, is an instance of a PTO rule making a substantive difference in Applicants' ability to claim their invention and, therefore, must be considered a substantive rule. The requirement denies Applicants rights and benefits expressly conferred by the patent statute. The measure of the value of these denied rights and benefits is that the requirement, as applied here, would deny Applicants the full and complete PTO

examination of Applicants' claims on their merits, as specified by 37 C.F.R. § 1.105. In addition, to file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications based on the PTO's incomplete examination on the merits would deny Applicants the benefit of the full patent term of 17 years on each of Applicants' respective applications. Applicants respectfully submit that the requirement has a huge impact on their rights and interests in the presently claimed invention.

**c. Conclusion: Substantive Rule**

In summary, the requirement is a change to long existing practice and/or has a substantive impact on the rights and interests of Applicants to their invention. Either finding means that the new requirement is a substantive rule. Since the Commissioner has no power to issue substantive rules, the requirement is an improperly promulgated substantive rule having no force of law.

**3. The PTO Requirement is Outside the Scope of 37 C.F.R. § 1.78 (b)**

Rule 78 (b) states that:

Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

The only **requirement** that Rule 78 (b) authorizes is the elimination of conflicting claims from all but one co-pending applications.

In the instant Final Office Action, Examiner has not required the elimination of all conflicting claims from all but one application, but instead has required Applicants to: 1) file terminal disclaimers in each of the related 328 applications; 2) provide an affidavit; or 3) resolve all conflicts between claims in the related 328 applications. None of the options in the requirement is authorized by Rule 78 (b), and therefore Applicants respectfully submit that such a requirement is improper.

With respect to the PTO's authority to act within Rule 78 (b) regarding the rejection of conflicting claims, MPEP § 822.01 states that:

Under 37 CFR § 1.78 (b), the practice relative to overlapping claims in applications copending before the examiner..., is as follows: Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, *a complete examination should be made of the claims of each application* and all appropriate rejections should be entered in each application, including rejections based upon prior art. *The claims of each application may also be rejected on the grounds of provisional double patenting on the claims of the other application* whether or not any claims avoid the prior art. Where appropriate, the same prior art may be relied upon in each of the applications. MPEP 822.01 (6th Ed., Rev. 3, 1997), (*emphasis added*).

In light of the requirement of the Final Office Action, MPEP § 822.01 and 37 CFR § 1.78 (b) are not applicable since there has not been any rejection with regard to the elimination of conflicting claims from all but one co-pending application.

**4. The Assertion That Failure to Comply with the Requirement Will Result in Abandonment of Applicants' Application is Improper**

Applicants' prospective failure to comply with the above requirements cannot properly result in abandonment of the present application. Applicants respectfully submit that abandonment of an application can properly occur only:

- (1) for failure to respond within a provided time period (under Rule 135);
- (2) as an express abandonment (under Rule 138); or
- (3) the result of failing to timely pay the issue fee (under Rule 316).

There is no provision in the rules permitting abandonment for failure to comply with any of the presented requirements. To impose an improper requirement upon Applicants and then hold the application is to be abandoned for failure to comply with the improper requirement violates the rules of practice before the USPTO. Furthermore, Examiner is in effect attempting to create a substantive rule which is above and beyond the rulemaking authority of the USPTO, and therefore is invalid.



In the *Application of Mott*, 539 F.2d 1291, 190 USPQ 536 (CCPA 1976), the applicant had conflicting claims in multiple applications. The CCPA held that action by the Examiner which would result in automatic abandonment of the application was legally untenable. *Id.* at 1296, 190 USPQ at 541. In the present application, Examiner has asserted that there are conflicting claims in multiple applications, and that non-compliance of the Final Office Action's requirement will result in an automatic abandonment. Therefore, under *Mott's* analysis, the Final Office Action's result of abandonment of Applicants' application is legally untenable.

#### **5. Response to Apparent Conflict of Claims**

Applicants submit that the presentation of the Final Office Action Appendix fails to demonstrate any conflicts between claims of the present application and claims of the co-pending applications. Rather, the Final Office Action Appendix compares representative claims of *other* applications in attempt to establish that "conflicting claims exist between the 328 related co-pending applications." Absent any evidence of conflicting claims between the Applicants' present application and any other of Applicants' co-pending applications, any requirement imposed upon Applicants to resolve such alleged conflicts is improper.

#### **6. Request for Withdrawal of Requirement**

Therefore, Applicants respectfully request that Examiner reconsider and withdraw the requirement that Applicants: (1) file terminal disclaimers in each of the related 328 applications terminally disclaiming each of the other 327 applications; (2) provide an affidavit attesting to the fact that all claims in the 328 applications have been reviewed by applicant and that no conflicting claims exist between the applications; or (3) resolve all conflicts between claims in the above identified 328 applications by identifying how all the claims in the instant application are distinct and separate inventions from all the claims in the above identified 328 applications, which upon failing to do so will abandon the application.

## **7. Filing of Supplemental Oath**

Notwithstanding the foregoing, Applicants will file a supplemental oath under 37 C.F.R. § 1.67 for each application when Examiner identifies allowable subject matter. Applicants respectfully propose that the filing of individual supplemental oaths attesting to the absence of claim conflicts between previously patented claims and subsequently allowed claims is a more reasonable method of ensuring the patentable distinctness of subsequently allowed claims.

Under 37 C.F.R. § 1.105, § 1.106 & § 1.78 (b), Examiner has the duty to make every applicable rejection, including double patenting rejection. Failure to make every proper rejection denies Applicants all rights and benefits related thereto, e.g., Applicants' right to appeal, etc. Once obviousness-type double patenting analysis has been applied and conflicting claims have been determined to exist, only a *provisional* obviousness-type double patenting rejection is possible until claims from one application are allowed.

### **D. Information Disclosure Statement**

The Applicants appreciate the Examiner's review of the Information Disclosure Statements filed 1/30/96, 2/1/96, 4/5/96, and 4/7/97 and have addressed those specific concerns raised in paragraph 7 of the Final Office Action. It is the Applicants' understanding that the Examiner raised the following 5 issues:

- (1) the reasons for such a large number of references cited,
- (2) foreign language references cited without a statement of relevance or translation have not been considered,
- (3) the relevancy of numerous references listed in the Information Disclosure Statements are subsequent to the Applicants' latest effective filing date of 11/3/81,
- (4) citation of references apparently unrelated to the subject matter of the claimed invention, and
- (5) citation of database search results listed in foreign languages where no copy was provided.

### **1. Reason for Citation of Large Number of References**

The reason that the Applicants submitted such a large number of references in the Information Disclosure Statements was that a large portion of the information cited by the Applicants was brought to the Applicants' attention in the discovery processes in a previous litigation in the United States District Court for the Eastern District of Virginia (*Personalized Mass Media Corp. v. The Weather Channel, Inc.* Docket No. 2:95 cv 242) and an investigation by the International Trade Commission (*In the Matter of Certain Digital Satellite System (DSS) Receivers And Components Thereof*, No. 337 TA 392, which was direct to U.S. Pat. No. 5,335,277) regarding claims in the Applicants' related issued patents. The documents listed in the Information Disclosure Statement were cited during the previous litigation/investigative proceedings by the alleged infringers in the aforementioned proceedings as being relevant and material to patentability of the claims in the related patents. The Applicants submitted those materials in the Information Disclosure Statement to the PTO at the earliest possible time in order to file them in compliance with the 3 month requirement stated in the certification used to submit the Information Disclosure Statement before the Final Office Action was issued as is necessary under 37 CFR § 1.97 (c) (1). In such haste, entries were inadvertently submitted which do not appear on their face to be material to the patentability of the present application. Applicants have corrected this error with the submission of the corrected Information Disclosure Statement as shown in Appendix B. However, it is the Applicants' understanding that not all references cited must be material to patentability in order for such references to be considered. In § 609 of the MPEP, it states,

“[t]hese individuals also may want the Office to consider information for a variety of reasons: e.g., without first determining whether the information meets any particular standard of materiality, or because another patent office considered the information to be relevant in a counterpart or related patent application filed in another country, or to make sure that the examiner has an opportunity to consider the same information that was considered by the individuals that were substantially involved in the preparation or prosecution of a patent application.”

Applicants' position is that information that was considered material in previous litigation would fall into the 'variety of reasons' category as stated above. Applicants intention was not to confuse or make difficult the examination process for the Examiner, but was instead to be forthright and open in disclosing all information deemed to be relevant to the application in issue by third parties.

## **2. Citations of Foreign Language References**

Applicants have re-examined the foreign references listed in all of the Information Disclosure Statements and have either eliminated such references from the list, included translations herewith or provided statements as to the relevancy of such references (APPENDIX A). The inclusion of translations with this response is in compliance with 37 C.F.R. § 1.97 (f) which states in part, "[I]f a bona fide attempt is made to comply with 37 C.F.R. § 1.98, but part of the required content is inadvertently omitted, additional time may be given to enable full compliance." The omission of any translations and/or relevancy statements for foreign references were inadvertent and unintentional and are herein submitted in accordance with 37 C.F.R. § 1.97 (f).

## **3. References in the Information Disclosure Statements Subsequent to Applicants' Latest Effective Filing Date of 9/11/87**

Examiner stated "[n]umerous references listed in the IDS are subsequent to the applicant's latest effective filing date of 9/11/87, therefore, the relevancy of those references is unclear." Upon further examination, the Applicants have eliminated those patents and publications after the effective filing date for the present application. It is the Applicants' understanding that the effective filing date for the present application is 11/3/81.

## **4. Citation of Unrelated References**

Applicants appreciate the Examiner pointing out such references that were listed yet on their face appear to be unrelated to the subject matter of the present application. In response to such information, the Applicants have reviewed the cited references and removed any such

references which appear to be unrelated on their face to the claimed subject matter such as the patent for a beehive, the patent for a chemical compound and numerous computer printout search results.

## **5. Citation of Database Search Results**

Database search results listed in foreign languages where no copy was provided have been eliminated from the substitute Information Disclosure Statement included with this office action.

The Applicants offer the corrected Information Disclosure Statement (APPENDIX B) as a substitute to the previously filed Information Disclosure Statement filed 4/7/97. No new entries have been entered, only citations which have, upon further examination, been determined not to be relevant to the claimed subject matter have been eliminated, typographical errors have been corrected, dates inserted where possible and the list shortened as a result. It is the Applicants' intention that such corrected Information Disclosure Statement will help clarify any issues previously raised by the Examiner and aid in the prosecution of the present patent application.

## **E. Response to Rejections under 35 U.S.C. § 112**

### **1. Specification Support of Claims 56-92**

Paragraph 8 of the Final Office Action rejects claims 56-92 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Final Office Action specified essentially all of the language of claims 56-92 as not being supported by the specification as originally filed.

The following tables list Applicants' claim language in the left column which corresponds to the specification support from Applicants' earliest priority document in the right column.

**a. Claim 56**

displaying video that at least one of describes and promotes a transaction . . . to receive input from a user	Col. 20 lines 16-22 with col. 20 lines 58-59, col. 20 line 25.
receiving a reply from said user . . . having a processor . . . processing said reply and delivering to a first output device . . . an acknowledgment that designates said transaction	Col. 20 lines 24-27; col. 20 line 34; col. 20 lines 32-34; for example, col. 20 line 45; col. 20 lines 44-47.
selecting, based on said step of receiving, one of a code that designates said transaction . . . a device for communicating to a remote site information evidencing said step of receiving	Col. 20 lines 44-47 or lines 50-53, with, for example, col. 15 lines 57-60; col. 18 lines 36-38; col. 15 lines 54-56.
communicating said selected one of said code and said datum to said remote site, . . . a network that includes at least one receiver site, at least one processor site and at least one transmitter site	For example, col. 15 lines 20-25 or col. 20 lines 54-57; see connection to element 200 in Fig. 6D; col. 20 line 57; col. 20 line 55; col. 20 line 56.
delivering at least one processor instruction . . .	For example, col. 9 lines 21-23, col. 7 lines 50-58, col. 8 lines 60-65, or col. 20 lines 34-43.
delivering one of said transaction and said acknowledgment on the basis of said at least one processor instruction . . .	Col. 20 lines 47-50 or lines 55-59.

**b. Claim 57**

said at least one processor instruction . . . to process at least one discrete signal	Col. 20 lines 32-34, col. 20 lines 39-41 with col. 3 lines 3-5.
receiving one of a broadcast information transmission . . . containing a video graphic and said . . . discrete signal . . . designating second code	Col. 18 lines 13-14 and fig. 6B, col. 19 lines 55-56, col. 20 lines 28-31 and 38-39, col. 20 line 42.

**c. Claim 58**

a control signal is generated based on said at least one processor instruction	Col. 19 line 24, col. 19 lines 20-21.
selecting a video graphic in response to said generated control signal	Col. 19 lines 24-25 with 55-56.
outputting a video graphic . . .	Col. 19 lines 28-29 with 55-56.
processing user input . . .	Col. 19 lines 39-41 with col. 19 line 67 through col. 20 line 1.
generating at least a portion of a video graphic image . . .	Col. 19 line 67 through col. 20 line 1.
outputting one of a simultaneous presentation . . .	Col. 19 line 67 through col. 20 line 2.

**d. Claim 59**

controlling one of (i) a receiver . . . (vi) a second output device . . .	Col. 19 lines 24-25, col. 19 lines 28-29 and 64-66.
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**e. Claim 60**

generating . . . at least one receiver specific datum . . .	Col. 19 line 68 through col. 20 line 1.
outputting one of a simultaneous presentation . . .	Col. 19 line 68 through col. 20 line 2.

**f. Claim 61**

receiving a plurality of discrete signals . . .	For example, col. 9 lines 41-57 or col. 18 lines 59-60.
assembling said plurality of discrete signals into said at least one processor instruction, . . . assembling said one of a code that designates said transaction and a datum that designates said transaction . . .	Col. 7 lines 36-39 with col. 2 lines 64-65 and col. 3 lines 3-5; Col. 7 lines 36-39 with, for example, col. 2 lines 65-66.

**g. Claim 62**

communicating said at least one processor instruction to said designated specific processor	Col. 18 lines 2-4.
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**h. Claim 63**

wherein said at least one processor instruction further designates a specific user input to process	Col. 20 lines 32-33.
generating output by processing said specific user input	Col. 20 lines 24-27, 32-34, and 43-47.

**i. Claim 64**

receiving at least one control signal which enables a receiver station to at least one of (i) process said at least one processor instruction and (ii) output said at least a portion of said at least one video graphic	Col. 13 lines 17-20 with col. 20 lines 38-41 and col. 7 lines 46-47, col. 7 lines 50-58 with col. 17 line 44, col. 19 lines 63-64 with col. 19 line 65 through col. 20 line 1.
enabling said receiver station to said at least one of (i) process said at least one processor instruction and (ii) output said at least a portion of said at least one video graphic . . .	Col. 20 lines 46-47, col. 20 lines 41-43, col. 19 line 65 through col. 20 line 1.

**j. Claim 65**

said at least one processor instruction designates a second code which generates . . . video graphic . . .	Col. 19 lines 64-67 with col. 19 lines 48-53, including "upon command" at line 53.
communicating to a remote station information evidencing at least one of the availability, use, and usage of at least one of (i) said at least one processor instruction, (ii) said designated second code, and (iii) said . . . video graphic	For example, col. 20 lines 55-59 with 45-47, col. 18 lines 30-42 with col. 18 line 41, col. 15 lines 29-30; col. 15 lines 52-60; col. 16 lines 18-21.



**k. Claim 66**

<p>the step of selecting evidence information . . . designates at least one of:</p> <ul style="list-style-type: none"> <li>(1) a video</li> <li>(2) a use of programming</li> <li>(3) a transmission station</li> <li>(4) a receiver station</li> <li>(5) a network</li> <li>(6) a broadcast station</li> <li>(7) a channel on a cable system</li> <li>(8) a time of transmission</li> <li>(9) a unique identifier datum</li> <li>(10) at least one of a source and a supplier of said data</li> <li>(11) at least one of a distributor and an advertisement</li> <li>(12) an indication of copyright</li> </ul>	<p>For example, col. 20 lines 50-59;</p> <p>for example, col. 18 lines 32-38, for example, col. 2, line 68; for example, col. 15, line 60; for example, col. 8, lines 23-24; for example, col. 15, line 59; for example, col. 15, line 60; for example, col. 15, line 61; for example, col. 15, line 61-62; for example, col. 15, line 62; for example, col. 15, line 65;</p> <p>for example, col. 15, lines 67-68;</p> <p>for example, col. 21 lines 1 through col. 22 line 4, including "Copyrighted Materials" at line 2; col. 21 lines 67 through col. 22 line 2; and "This signal indicates" at col. 20 line 54.</p>
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**l. Claim 67**

<p>the steps of communicating said second code to said processor . . . one selected from the group consisting of:</p> <ul style="list-style-type: none"> <li>(1) receiving a signal containing at least portion of said data . . .</li> <li>(6) delivering a receiver specific datum at said interactive video apparatus one of simultaneously and sequentially</li> </ul> <p>with at least one of said video and at least a portion of said data</p>	<p>Col. 19 lines 18-21 with col. 15 lines 57-60,</p> <p>col. 19 lines 28-29 and col. 20 lines 60-68,</p> <p>col. 19 line 67 through col. 20 line 2,</p> <p>col. 19 lines 67 through col. 20 line 1 and col. 20 line 6, col. 20 lines 1-2, col. 20 lines 47-50.</p>
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**m. Claim 68**

one of said at least one processor instruction is delivered in a multichannel signal	Col. 19 lines 14-15, 20-23, and 60-65.
the step of tuning a converter to receive said at least one processor instruction	Col. 19 lines 24-25.

**n. Claim 69**

programming . . . to query a remote data source . . .	Col. 18 lines 47-48 with col. 19 lines 38-39.
delivering . . . processed information of a stored datum . . .	Col. 19 line 67 through col. 20 line 1 with col. 18 lines 47-48 or col. 19 lines 39-41.
storing said reply . . .	Col. 20 lines 24-27.
assembling . . . information evidencing said reply	Col. 20 lines 44-47 with col. 9 line 68 through col. 10 line 4 and col. 20 lines 55-59.

**o. Claim 70**

storing a subscriber instruction to receive at least one of specific videos . . .	Col. 19 lines 5-8.
receiving said at least one of said specific videos . . . in accordance with said subscriber instruction	Col. 19 lines 23-25, col. 19 lines 5-13.

**p. Claim 71**

programming said processor to respond to at least one of said data and an instruct signal . . .	Col. 18 lines 47-48 and col. 19 lines 42-44.
receiving said information transmission . . .	Col. 19 lines 24-25.
inputting at least a portion of said . . . transmission to a control signal detector	Col. 19 lines 28-29 with col. 17 line 65 through col. 18 line 1 and col. 18 lines 14-21.
detecting said at least one of said data . . .	Col. 18 lines 60-63.
passing said at least one of said data . . . to said processor	Col. 8 lines 64-66, col. 18 line 66.

**q. Claim 72**

said at least one processor instruction is embedded in a non-visible portion of a signal containing said video	Col. 19 lines 42-48 with col. 4 lines 17-22.
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**r. Claim 73**

said at least one processor instruction is embedded in a non-visible portion of a television signal	Col. 19 lines 42-48 with col. 4 lines 17-22.
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**s. Claim 74**

said data include at least one of text and at least one video graphic for output.	Col. 20 lines 47-50, col. 20 lines 1-2.
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**t. Claim 89**

receiving one of a broadcast information transmission . . . containing a video graphic and said at least one processor instruction	Col. 18 lines 13-14 and fig. 6B, col. 19 lines 55-63 with 42-44.
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**u. Claim 90**

receiving one of a broadcast information transmission . . . containing said at least one discrete signal and said at least one processor instruction	Col. 18 lines 13-14 and fig. 6B, col. 20 lines 38-39 with col. 3 lines 3-5, col. 20 lines 28-32.
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**v. Claim 91**

receiving one of a broadcast information transmission . . . containing downloadable code and said at least one processor instruction	Col. 18 lines 13-14 and fig. 6B, col. 4 lines 5-13 with col. 2 lines 66-67 and col. 20 line 32.
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**w. Claim 75**

delivering a video presentation at at least one receiver station of a plurality of receiver stations each of which includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one control signal and programmed to process downloadable processor instructions, said video presentation including (a) a first video image and, (b) a second video image, said second video image (i) containing at least one datum . . . and (ii) overlaying said first video image	Col. 19 line 67 through col. 20 line 2, col. 3 lines 48-51,  col. 19 lines 28-29, col. 18 lines 14-15, col. 19 line 65, col. 19 line 66, col. 18 lines 14-15,  col. 19 lines 42-44,  col. 19 line 67 through col. 20 line 2, col. 19 line 68 through col. 20 line 1.
receiving . . . said downloadable processor instructions . . . instruct said at least one receiver station to one of generate and output a specific portion of said video presentation . . . having . . . a target processor to process data	Col. 10 lines 61-64 with col. 19 lines 60-63, col. 4 lines 5-13 and col. 19 lines 43-44,  col. 19 lines 45-53 and 64-67,  col. 17 lines 39-44, col. 17 line 62 through col. 18 line 4.
transferring said . . . instructions . . .	Col. 11 lines 50-57 with col. 19 lines 43-44.
receiving said . . . control signal . . . to control one of (i) an execution of said . . . instructions and (ii) a delivery of . . . said video presentation;	Col. 10 lines 61-64 with col. 19 lines 60-63, col. 19 lines 64-66 with col. 19 lines 45-53 including "upon command" at line 53, col. 19 line 64 through col. 20 line 2.
transferring said . . . control signal . . .	Col. 11 lines 50-57 with col. 4 lines 5-13.
transmitting an information transmission comprising said downloadable processor instructions and said at least one control signal	Col. 11 lines 50-57, col. 4 lines 5-13, col. 19 lines 20-23, and col. 19 lines 42-67.

**x. Claim 76**

receiving at least a portion of said first video image . . . at said transmitter station	Col. 10 lines 61-64 with col. 10 line 28, col. 10 lines 13-20.
transmitting said . . . video image . . . to said at least one receiver station	Col. 11 lines 50-57 with col. 19 lines 14-15 and 22-23, col. 19 lines 28-29.

**y. Claim 77**

one of downloadable code . . .  is embedded . . . a signal containing . . . video image.	Col. 11 lines 3-14, including "code reader" at col. 11 line 12; col. 4 lines 5-13 and 18-22 with col. 10 lines 25-28 and col. 19 lines 22-23.
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**z. Claim 78**

said video presentation is displayed . . . and downloadable code programs . . . (i) to output at least one of video, audio . . . (ii) to process a viewer reaction . . . (iii) to select information that supplements said video presentation	Col. 19 line 67 through col. 20 line 2, col. 19 lines 42-48, col. 19 line 68 through col. 20 line 1, col. 20 lines 28-32 with col. 20 lines 24-27.
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**aa. Claim 79**

said at least one control signal contains downloadable code	Col. 19 lines 60-66
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**bb. Claim 80**

delivering a video presentation . . . includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one signal	Col. 3 lines 48-66, col. 19 lines 28-29, col. 18 lines 14-15, col. 19 line 65, col. 19 line 66.
receiving . . . video . . .	Col. 19 lines 55-63.
delivering a signal containing said video . . . an instruct signal that instructs . . . at least one of (i) one of generate and output a specific portion of a video presentation and (ii) deliver data . . .	Col. 19 lines 55-63; col. 19 lines 60-65; col. 19 line 64 through col. 20 line 2, including "the first overlay" at lines 65-66.
receiving . . . at least one control signal . . . controls the communication of at least one of said video and said instruct signal	Col. 19 lines 60-63 with col. 11 lines 38-39; col. 11 lines 38-43 and, for example, lines 50- 57.
transmitting said at least one control signal from said origination transmitter before a specific time	Col. 19 lines 60-63 and col. 11 lines 38-43 before, for example, col. 11 lines 54-57 or "then" at col. 19 line 68.

**cc. Claim 81**

said at least one control signal comprises at least one of code and a datum . . . identifies at least one of (i) said video and (ii) data . . .	Col. 11 lines 38-39, col. 15 lines 57-59, col. 11 lines 38-39, col. 11 lines 38-39 with col. 19 lines 20-23, col. 20 lines 16-24 with col. 11 line 22 and col. 20 lines 47-55.
transmitting . . . a second control signal . . . controls the communication of said at least one of said video . . .	Col. 11 lines 39-41, col. 11 lines 50-57.

**dd. Claim 82**

embedding a specific one of said at least one control signal in . . . a signal containing said video . . .	Col. 4 lines 5-13 with lines 18-22.
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**ee. Claim 83**

said specific time is a scheduled time . . .	Col. 11 line 22 with lines 38-43.
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**ff. Claim 92**

said at least one control signal . . . to control at least one of a plurality of selective transfer devices at different times	Col. 11 lines 38-46 with, for example, col. 11 lines 57-65 and col. 10 lines 49-52.
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**gg. Claim 84**

delivering a video presentation at at least one receiver station of a plurality of receiver stations each of which includes a receiver, a signal detector, a processor, and an output device, and is adapted to detect the presence of at least one signal	Col. 3 lines 48-66,  col. 19 lines 28-29, col. 18 lines 14-15, col. 19 line 65, col. 19 line 66, col. 18 lines 14-15.
receiving video . . .	Col. 10 lines 28 and 61-63.
delivering said video . . .	Col. 10 lines 40-47.
receiving at least one instruct signal . . . instruct . . .  to deliver . . .  said video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video	Col. 10 lines 61-63 with col. 4 lines 5-13; for example, col. 19 lines 64-65 or col. 20 line 32; for example, col. 19 lines 65-66 or col. 20 lines 34-43; col. 20 lines 1-2 or lines 16-20; col. 19 line 67 through col. 20 line 2; col. 20 lines 47-50; col. 20 lines 6-17.
transferring said at least one instruct signal . . .	Col. 10 lines 40-47 with col. 4 lines 5-13.
transmitting said video and said at least one instruct signal . . .	Col. 10 lines 40-47 with col. 4 lines 5-13 and col. 19 line 63 or col. 20 lines 28-30.

**hh. Claim 85**

at least one of identification data . . . is embedded in a signal containing said video	Col. 19 lines 14-15, col. 4 lines 5-13 and col. 19 line 15.
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**ii. Claim 86**

transmitting directs said video . . . at the same time . . .	Col. 19 lines 60-63 with col. 19 lines 45-48,
and responds to said at least one instruct signal concurrently	col. 19 line 59 through col. 20 line 2 with col. 3 lines 48-50.

**jj. Claim 87**

transmitting directs said video . . . at different times and . . .	Col. 19 lines 60-63 with col. 19 lines 45-48,
responds to said at least one instruct signal at a different time	col. 11 lines 52 and 59-60, col. 19 line 59 through col. 20 line 2 with col. 3 lines 48-50.

**kk. Claim 88**

receiving said video . . .	Col. 10 lines 61-64 with line 28.
communicating said video . . .	Col. 11 lines 62-64.
storing said video . . . prior to delivering said video to said transmitter	Col. 11 lines 58-60 and lines 64-65, col. 11 lines 41-46 with col. 10 lines 49-52 and figs. 3B and 3C.

**2. Rejections Under 35 U.S.C. §112, Second Paragraph**

Claims 56-74 and 77-79 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention.

In the Final Office Action it is noted that with respect to claim 56, an acknowledgment that designates the transaction, a code that designates the transaction, and a datum that designates the transaction are each claimed. It is queried whether the same feature is claimed. The inconsistent claim language is appropriate, as each separate feature set forth is not necessarily the same.

With respect to claim 57, it is queried to what is “at least one discrete signaling appearance referring to.” By the present amendment, claim 57 is amended to replace the term “discrete signaling appearance” with the term “discrete signal”. The discrete signal is originally



introduced in claim 57 and finds support in the original disclosure at column 3 lines 3-5 as discussed above in section 1.b.

With respect to claim 61, it is asserted that the language said one of said code and said datum is said code has no clear meaning. By the present amendment this language has been deleted.

With respect to claim 64, in the Final Office Action, it is asserted that the language at least a portion of at least one video graphic has no clear meaning. Applicants respectfully disagree. Claim 64 sets forth that said at least one processor instruction generates at least a portion of at least one video graphic for output. Read in context the language specified as having no clear meaning has a definite clear meaning in accordance with the provisions of 35 U.S.C. § 112, second paragraph.

With respect to claim 65, it is queried whether the second code is different from the code, datum, and acknowledgment defined in claim 56. The second code is distinctly set forth in claim 65 as it is not necessarily the same as the code, the datum, and the acknowledgment defined in claim 56. A similar problem as that addressed above with respect to claim 64 was also asserted. The reasoning set forth above with respect to claim 64 is equally applicable with respect to claim 65.

With respect to claim 66, it is noted that the language “at least one of said code and said datum is at least one of stored and communicated to a remote data collection station” is unclear. Applicants, by the present amendment, have amended claim 66 to clearly refer to said at least one of code and a datum originally introduced in the step of selecting of claim 56. The selected code or datum is stored or is communicated as set forth by claim 66.

With respect to claim 67, it is queried whether the second code is different from the code, datum, and acknowledgment defined in claim 56. The second code is distinctly set forth in claim 65 as it is not necessarily the same as the code, the datum, and the acknowledgment defined in claim 56. It is noted that the terms “said video output device”, “said audio output device” and “said print output device” lack antecedent basis. Claim 67 has been amended by the present

amendment to positively refer to “a video output device, an audio output device and a print output device.” It was further asserted that the term said data lacks antecedent basis. Applicants respectfully submit that the term said data finds antecedent basis in line 1 of claim 56.

With respect to claim 70, it is asserted that in the last line said subscriber instruction lacks antecedent basis. Applicants respectfully submit that said subscriber instruction finds antecedent basis in line 2 of claim 70.

With respect to claim 71, it is queried whether the at least one of data and an instruct signal are different from those defined in claim 56. The at least one of said data and an instruct signal is not necessarily the same as any of the features originally introduced in claim 56 and is thus appropriately positively set forth in claim 71.

With respect to claims 89-91, a similar problem as addressed above with respect to claim 57 was asserted. Applicants respectfully submit that the claim language meets the specific requirements of 35 U.S.C. § 112, second paragraph, for the reasons set forth above with respect to claim 57. It is also queried whether the second code is different from the code defined in claim 56. The second code is distinctly set forth in claim 65, as it is not necessarily the same as the code defined in claim 56.

With respect to claim 75, it is asserted, in the Final Office Action, that the phrase “(i) containing at least one datum that at least one of completes and supplements said first video image and (ii) overlaying said first video image,” in lines 7-8 of the claim as previously amended, have no clear meaning. Applicants respectfully disagree. Claim 75 sets forth a second video image that contains at least one datum. The second video image also overlays said first video image. The datum either completes or supplements said first video image. Applicants respectfully submit that the claim language has this clear meaning.

With respect to claim 77, it is asserted that the phrase “one of downloadable code and identification data in respect of said downloadable code” in lines 1-3 of the claim as previously amended has no clear meaning. Applicants respectfully disagree. Claim 77 sets forth that either downloadable code or identification data in respect of said downloadable code is embedded in a

portion of a signal. Applicants respectfully submit that the claim language has this clear meaning. It is further queried whether the downloadable code and identification data are different from the control signal, datum, and downloadable instructions defined in claim 75. The downloadable code and identification data are not necessarily the same as the recited control signal, datum, or downloadable instructions.

With respect to claim 78, it is queried whether the downloadable code is different from the control signal, datum, and downloadable instructions defined in claim 75. The downloadable code is not necessarily the same as the recited control signal, datum, or downloadable instructions.

With respect to claim 79, it is queried whether the downloadable code is different from the control signal, datum, and downloadable instructions defined in claim 75. The downloadable code is not necessarily the same as the recited control signal, datum, or downloadable instructions.

With respect to claim 80, it is queried whether the at least one signal, recited in line 4 of the previously amended claim, and the signal, which was introduced in line 8 of the claim as previously amended, are the same. The preamble of the claim sets forth receiver stations with reference to a generic at least one signal through the claim language “receiver stations adapted to detect the presence of at least one signal.” The preamble does not define the signal to be detected. A signal is positively recited in line 7 of claim 80 above. This signal is not necessarily the same as the generic at least one signal recited in the preamble to set forth the receiver stations. It is also queried to what “said signal” in line 9 of the claim as previously amended refers. “Said signal” clearly refers to the “signal” positively introduced in line 7 of claim 80 above.

With respect to claim 84, it is asserted that line 11 of the claim as previously amended has no clear meaning. Applicants respectfully disagree. Claim 84 sets forth an instruct signal that instructs a receiver station to deliver a presentation. The presentation is of video and either (i) at least one receiver specific datum or (ii) at least one datum that is either described or promoted in

said video. Applicants respectfully submit that the claim language “at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video” clearly sets forth a component of the presentation.

### **3. Conclusion**

Applicants respectfully submit that claims 56-92 of the subject application particularly point out and claim the subject matter sufficiently for one of ordinary skill in the art to comprehend the bounds of the claimed invention. The test for definiteness of a claim is whether one skilled in the art would understand the bounds of the patent claim when read in light of the specification, and if the claims so read reasonably apprise those skilled in the art of the scope of the invention, no more is required. *Credle v. Bond*, 25 F.3d 1556, 30 U.S.P.Q.2d 1911 (Fed. Cir. 1994). The legal standard for definiteness is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 33 F.3d 1354, 31 U.S.P.Q.2d 1754 (Fed. Cir. 1994). Applicants have amended the claims to enhance clarity and respectfully submit that all pending claims are fully enabled by the specification and distinctly indicate the metes and bounds of the claimed subject matter.

Applicants believe that the above recited changes are sufficient to overcome the rejections under 35 U.S.C. § 112, first and second paragraph, and respectfully request withdrawal of these rejections. Applicants provide these specific embodiments in support of the pending claims by way of example only. The claims must be read as broadly as is reasonable in light of the specification, and Applicants in no way intend that their submission of excerpts/examples be construed to unnecessarily restrict the scope of the claimed subject matter.

### **F. Response to Rejection of Claims for Absence of Novelty**

#### **1. 35 U.S.C. § 102 (b) Rejection over Campbell et al., U.S. Patent No. 4,536,791**

Claims 56-74 and 89-91 stand rejected under 35 U.S.C. § 102 (b) as being anticipated by Campbell et al., U.S. Patent No. 4,536,791.

Applicants' maintain that Campbell et al. is not prior art under Section 102(b). In the Final Office Action it is noted that the Campbell et al. patent claims a parent application filed on March 31, 1980, and that there was a PCT equivalent application published in October of 1981. Even if it is assumed that these prior applications disclose the subject matter relied on in the rejection, the Campbell et al. patent fails to qualify as prior art under 35 U.S.C. § 102(b). Section 102(b) requires that the invention be patented or described in a printed publication more than one year prior to the date of the application for patent. The application filed March 31, 1980 was neither granted nor published. The PCT application was not published more than one year prior to Applicants' date of application for patent. Applicants accordingly respectfully request that the rejection under 35 U.S.C. § 102(b) over Campbell et al. be withdrawn.

**a. Claim 56**

Notwithstanding the availability of Campbell et al. as prior art under Section 102(b), Campbell et al. fail to anticipate Applicants' claim 56. Campbell et al. disclose an addressable cable television control system. In the Final Office Action, it is asserted that the pay-per-view premium programming feature, disclosed beginning at column 17, line 42, of the Campbell et al. patent, anticipates Applicants' claim 56. Campbell et al. fail to teach, *inter alia*, a processor capable of processing said reply and delivering to a first output device of said interactive video apparatus one of said transaction and an acknowledgment that designates said transaction. In the Final Office Action, it is asserted that the microprocessor that carries out the converter control logic process a reply. To the contrary, the converter merely "requests [a] data control system . . . to authorize reception of the [selected] channel" "[w]hen [a] key number is entered correctly." Campbell et al., col. 17 lines 58-61. There is no suggestion by Campbell et al. that the microprocessor is capable of delivering to a first output device the transaction or an acknowledgment that designates the transaction.

Notably absent from the system described by Campbell et al. is a step of selecting, based on said step of receiving, one of a code that designates said transaction and a datum that designates said transaction, said interactive video apparatus having a device for communicating

to a remote site information evidencing said step of receiving. In the Final Office Action, it is asserted that, according to the Campbell et al. system, “when the key number is entered correctly, the converter 40 requests the central data control system 12 at the head end to authorize the reception of the channel, also passing along appropriate transactional information for billing purposes.” Final Office Action, page 23, lines 5-7. Applicants respectfully submit that this statement is a mischaracterization of the teaching of Campbell et al. and disagree with the implication that the converter can be said to select code that designates said transaction or a datum that designates said transaction. There are only two exchanges disclosed by Campbell et al. between the converter and the data control system: the request by the converter to authorize reception of the channel and, subsequently, the command by the data control system to allow or disallow the selected program. Campbell et al. fail to teach, as the Final Office Action suggests, that the converter passes along appropriate transactional information for billing purposes. Campbell et al. merely indicate that the “data control system . . . retains billing information for the service as required.” Campbell et al., col. 17, lines 61-64. There is no indication that this information is received from the converter as suggested by the Final Office Action. Even assuming *arguendo* that this information is passed along by the converter, the billing information described in Campbell et al. is not selected from anything as are the code or datum that designate the transaction set forth in claim 56. Campbell et al. fail to teach that the converter select code that designates said transaction or a datum that designates said transaction.

There is no indication that the system of Campbell et al. selects anything, let alone code that designates said transaction or a datum that designates said transaction. When a key number is entered correctly, the system of Campbell et al. requests authorization, *i.e.* commands to allow or disallow, and retains information. *See* Campbell et al. col. 17, lines 58-64. In none of these actions does the Campbell et al. system pick from among several codes or data as is inherent in a step of selecting. In fact, the Campbell et al. system makes no choice at all. The actions of requesting, commanding, and retaining fail to anticipate Applicants’ claimed step of selecting,

based on said step of receiving, one of a code that designates said transaction and a datum that designates said transaction.

Campbell et al. fail to teach code that designates a transaction or a datum that designates a transaction. The Final Office Action apparently relies on the billing information retained by the data control system to show such a code or datum. However, the single reference to the billing information at col. 17, line 63, of Campbell et al. fails to define in any way the billing information. Campbell fails to teach that the billing information designates a transaction described or promoted by a step of displaying video as set forth by claim 56.

Accordingly, as no code or datum is selected by the Campbell et al. system, there is no suggestion for communicating said selected one of said code and said datum to said remote site. As noted above, the Final Office Action erroneously suggests that the converter passes along information for billing purposes. However, even assuming *arguendo* that such information is passed along by the converter, such information cannot be considered to be the selected one of said code and said datum as there is no suggestion that such billing information is selected from anything and no suggestion that such billing information designates a transaction described or promoted by a step of displaying video as set forth by claim 56.

Campbell et al. also fail to disclose a step of delivering at least one processor instruction at said interactive video apparatus based on one of said step of receiving and said step of communicating, said at least one processor instruction controlling said interactive video apparatus and delivering one of said transaction and said acknowledgment on the basis of said at least one processor instruction from said step of delivering. As noted above Campbell et al. fail to teach steps of receiving or communicating as set forth by claim 56. Accordingly, Campbell et al. cannot be said to teach a step of delivering said at least one processor instruction based on one of said step of receiving and said step of communicating. However, even assuming *arguendo* that the passing along of information for billing occurs and could be considered equivalent to Applicant's claimed step of communicating, there is no teaching by Campbell et al. of a step of delivering said at least one processor instruction in response to a step of communicating. Claim

56 sets forth at least one processor instruction that controls said interactive video apparatus. Said at least one processor instruction is delivered based upon said step of receiving or said step of communicating. On the basis of said at least one processor instruction one of said transaction and said acknowledgment is delivered. The Final Office Action fails to point out, and Campbell et al. fail to disclose, such at least one processor instruction. Campbell et al. disclose no processor instruction that controls an interactive video apparatus on which the processing of the entry of the key number and the delivery of the request is based, which is delivered in response to the “passing along” of information for billing purposes, and on the basis of which the key number is delivered. Campbell et al., thus, fail to disclose at least one processor instruction that is delivered in response to said step of communicating and on the basis of which one of said transaction and said acknowledgment is delivered.

Additionally, Campbell et al. fail to show displaying video that at least one of describes and promotes a transaction. Campbell et al. describe a system in which “a channel is selected on a key board.” Campbell et al., col. 17 line 54. This selection is made without any description or promotional video display by the Campbell et al. system. As Campbell et al. fail to teach displaying video as presently claimed, Campbell et al. cannot teach receiving a reply from said user at said input device in response to said step of displaying.

Applicants respectfully submit that the cited art does not anticipate claim 54 since the reference fails to disclose every element of the claimed invention, and Applicants respectfully request that the 35 U.S.C. § 102 (b) rejection of claim 54 be withdrawn.

**b. Dependent Claims 57-74 and 89-91**

Claims 57-74 and 89-91 depend upon independent claim 56. As discussed *supra*, Campbell et al. fails to disclose every element of claim 56 and thus, *ipso facto*, Campbell et al. fails to anticipate dependent claims 57-74 and 89-91, and therefore, this rejection should be withdrawn and the claims be permitted to issue.



**2. 35 U.S.C. § 102 (b or e) Rejection over Hedger  
("Broadcast Telesoftware: Experience With  
ORACLE")**

Claims 75-79 are rejected under 35 U.S.C. § 102 (b or e) as being anticipated by Hedger ("Broadcast Telesoftware: Experience With ORACLE") [hereinafter Hedger].

The present application claims priority under 35 U.S.C. § 120 to the '81 case, App. Ser. No. 06/317,510, filed November 3, 1981 and issued as U.S. Pat. No. 4,694,490. 35 U.S.C § 102(b) states that a person shall be entitled to a patent unless the invention was described in a printed publication in this or a foreign country, more than one year prior to the date of the application of patent in the United States. Applicants submit that the only reference to the publication date in Hedger is a copyright date of 1980. Since the printed publication date of "1980" is not necessarily more than one year prior to Applicants' priority date of November 3, 1981, it has not been established that the printed publication of Hedger occurred more than one year prior to the Applicants' date of application. Accordingly, the rejection of claims 75-79 under 35 U.S.C. § 102(b) is improper. 35 U.S.C. § 102(e) states that a person shall be entitled a patent unless the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent. The Hedger reference is not a granted patent. Accordingly, the rejection of claims 75-79 under 35 U.S.C. § 102(e) is improper. Applicants respectfully request withdrawal of the relevant rejections. Assuming *arguendo* that Hedger is a valid reference, Applicants present the following arguments.

**a. Independent Claim 75**

With respect to Applicants' claim 75, Hedger fails to teach, *inter alia*, Applicants' claimed step of receiving said at least one control signal at said transmitter station, said at least one control signal being operative at said at least one receiver station to control one of (i) an execution of said downloadable processor instructions and (ii) a delivery of at least a portion of said video presentation. The Final Office Action is silent regarding the control signal set forth in

claim 75. Hedger fails to teach or describe any signals that control either an execution of downloadable processor instructions or a delivery of at least a portion of a video presentation. Hedger cannot, therefore, teach receiving such a control signal. Also, Hedger fails to teach any details regarding a transmitter station. Hedger, thus, fails to teach receiving a control signal at said transmitter station.

Furthermore, Hedger fails to teach, *inter alia*, Applicants' claimed step of transmitting an information transmission comprising the downloadable processor instructions and said at least one control signal and transferring said at least one control signal to said transmitter. As discussed *supra*, Hedger fails to teach a control signal as presently set forth. Hedger cannot, therefore, teach transferring such a control signal. Hedger also cannot teach an information transmission comprising such a control signal. Accordingly, Hedger fails to teach transmitting such an information transmission.

Hedger also fails to teach, *inter alia*, Applicants' claimed step of receiving at a transmitter station said downloadable processor instructions, wherein said downloadable processor instructions instruct said at least one receiver station to one of generate and output a specific portion of said video presentation, said downloadable processor instructions having at said at least one receiver station a target processor to process data. Hedger fails to teach any ' details regarding a transmitter station. In the Final Office Action, at pages 26-27, it is asserted, "It is inherent that . . . code is transmitted by a transmitter station upon user request of a particular program." Applicants' first note that Hedger fails to teach any transmission upon a user request as suggested in the Final Office Action. Notwithstanding, there is no teaching to receive at a transmitter station downloadable processor instructions. It is asserted in the Final Office Action that a transmitter station is inherent. However, it is not inherent that a transmitter station receive downloadable processor instructions as set forth by Applicants' claim.

Accordingly, as Hedger fails to teach downloadable processor instructions as presently set forth, Hedger cannot teach transferring said downloadable processor instructions to a transmitter as presently claimed.

Applicants respectfully submit that for at least these reasons, Hedger fails to show every element of claim 75 and that accordingly Hedger fails to anticipate claim 75 under 35 U.S.C. § 102(b or e).

**b. Dependent Claims 76-79.**

Claims 76-79 depend from, and thus include every limitation of, independent claim 75. As discussed *supra*, Hedger fails to teach every element of independent claim 75. Therefore, *ipso facto*, Hedger fails to teach every limitation of these dependent claims. Accordingly, Applicants respectfully submit that Hedger fails to anticipate claims 76-79 under 35 U.S.C. § 102 (b or e).

**3. 35 U.S.C. § 102 (b) Rejection over Gimple et al., U.S. Patent No. 4,430,731**

Claims 80-83 and 92 are rejected under 35 U.S.C. § 102 (b) as being anticipated by Gimple et al., U.S. Patent No. 4,430,731 [hereinafter Gimple]. The present application claims priority under 35 U.S.C. § 120 to the '81 case, App. Ser. No. 06/317,510, filed November 3, 1981 and issued as U.S. Pat. No. 4,694,490. 35 U.S.C § 102(b) states that a person shall be entitled to a patent unless the invention was patented or described in a printed publication more than one year prior to the date of the application for patent in the United States. Gimple was issued February 7, 1984. Gimple was thus neither patented nor printed more than one year prior to the effective filing date of November 3, 1981, of Applicants' claims. Accordingly, Applicants' respectfully submit that the rejection of claims 80 and 82 under 35 U.S.C. § 102(b) is improper and request the withdrawal of the rejection. Assuming *arguendo* that Gimple is a valid reference, Applicants present the following arguments.

**a. Independent Claim 80**

With respect to Applicants' claim 80, Gimple fails to teach, *inter alia*, Applicants' claimed step of delivering a signal containing said video to an origination transmitter, said signal containing said video also containing an instruct signal that instructs said at least one receiver

station to at least one of (i) one of generate and output a specific portion of a video presentation and (ii) deliver data that is at least one of described and promoted in said video. In the Final Office Action, at page 28, it is asserted that Gimple shows video having an instruct signal. Gimple, at column 3, lines 49-52, discloses, “Preferably the data is transmitted in packets of information, which includes destination address, instruction, data parity bits and termination bits.” The instruct signal as presently set forth instructs a receiver station to either (i) generate or output a specific portion of a video presentation or (ii) deliver data that is promoted in said video or to be displayed in said video. There is no teaching in Gimple of an instruct signal that instructs a receiver station to generate or output a specific portion of a video presentation. There is no teaching in Gimple of an instruct signal that instructs a receiver station to deliver data that is promoted in video or to be displayed in video. Gimple, therefore, fails to teach Applicants’ instruct signal as presently claimed. Gimple cannot thus teach a signal containing such an instruct signal or teach delivering such a signal.

Gimple also fails to teach, *inter alia*, Applicants’ claimed step of receiving, at said origination transmitter station, at least one control signal that, at the remote intermediate transmitter station, controls the communication of at least one of said video and said instruct signal. In the Final Office Action it is asserted that Gimple anticipates the claimed method including the receiving one or more control signals which at the remote intermediate transmitter station operate to control the communication of the video. There is no support in the Final Office Action for this assertion. The Final Office Action, at page 27, does reference disclosure by Gimple at column 2, lines 32-49, which discloses control signals and means for stripping off control signals from data signals and integrating new control signals. Gimple provides no teaching, however, of a control signal that controls the communication of video or an instruct signal as set forth by claim 80. Gimple, therefore, fails to teach receiving such a control signal.

Additionally, Gimple fails to teach, *inter alia*, Applicants’ claimed step of transmitting said at least one control signal from said origination transmitter before a specific time. First, as discussed *supra*, Gimple fails to teach a control signal as presently claimed. Gimple cannot,

therefore, teach transmitting such a control signal. Second, in the Final Office Action, at page 28, it is asserted that the specific time is the time the program is to be received by the subscriber. However, Gimple fails to disclose any *specific* time the program is to be received by the subscriber. Gimple, therefore, fails to teach a specific time before which a control signal is transmitted.

In summary, clearly absent from the system and method taught by Gimple are at least Applicants' claimed steps of delivering a signal containing said video to an origination transmitter, said signal containing said video also containing an instruct signal that instructs said at least one receiver station to at least one of (i) one of generate and output a specific portion of a video presentation and (ii) deliver data that is at least one of described and promoted in said video; receiving, at said origination transmitter station, at least one control signal that, at the remote intermediate transmitter station, controls the communication of at least one of said video and said instruct signal; and transmitting said at least one control signal from said origination transmitter before a specific time. Accordingly, for at least this reason, Applicants respectfully submit that Gimple fails to anticipate claim 80.

**b. Dependent Claims 81-83 and 92**

Claims 81-83 and 92 depend from independent claim 80. As discussed *supra*, Gimple fails to disclose every element of claim 80 and thus, *ipso facto*, Gimple fails to anticipate dependent claims 81-83 and 92, and therefore, this rejection should be withdrawn and the claims be permitted to issue.

**4. Conclusion**

Applicants further respectfully submit that claims 56-83, and 89-92 in the present application are not disclosed, taught, suggested, or implied by the applied prior art. For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). There must be no difference between the claimed invention and the reference

disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Foundation v. Genetech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001, 18 USPQ2d 1896 (Fed. Cir. 1991). Absence from a cited reference of any element of a claim negates anticipation of that claim by the reference. *Kloster Speedsteel AB v Crucible, Inc.*, 230 USPQ 81 (Fed. Cir. 1986), *on rehearing*, 231 USPQ 160 (Fed. Cir. 1986). Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. § 102 (b and e) of claims 56-83 and 89-92 be withdrawn.

### **G. Response to Obviousness Rejection of Claims**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference to combine the teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references combined) must teach or suggest all the claim recitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not based on Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). M.P.E.P. 706.02(j).

#### **1. 35 U.S.C. § 103 (a) Rejection over Gimple et al., U.S. Patent No. 4,430,731**

Claims 81, 83, and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gimple et al., U.S. Patent No. 4,430,731. As discussed above, Gimple fails to show the claimed steps of delivering a signal containing said video to an origination transmitter, said signal containing said video also containing an instruct signal that instructs said at least one receiver station to at least one of (i) one of generate and output a specific portion of a video presentation and (ii) deliver data that is at least one of described and promoted in said video and to be displayed in said video; receiving, at said origination transmitter station, at least one control signal that, at the remote intermediate transmitter station, controls the communication of at least one of said video and said instruct signal; and transmitting said at least one control signal from

said origination transmitter before a specific time which are included in each of claims 81, 83, and 92. Gimple fails to show or suggest these claimed steps as required to establish a rejection under 35 U.S.C § 103.

Claims 81, 83 and 92 depend upon independent claim 80. As discussed *supra*, Gimple et al. fails to disclose every element of claim 80 and thus, *ipso facto*, Gimple et al. fails to anticipate dependent claims 81, 83, and 92, and therefore, this rejection should be withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**2. 35 U.S.C. § 103 (a) Rejection over Gimple et al., U.S. Patent No. 4,430,731 in view of Millar et al., British Patent Specification 1,370,535**

Claims 84-86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gimple et al., U.S. Patent No. 4,430,731 [hereinafter Gimple] in view of Millar et al., British Patent Specification 1,370,535 [hereinafter Millar].

**a. Independent Claim 84**

With respect to Applicants' claim 84, Gimple in view of Millar fails to, *inter alia*, teach or suggest each of the claimed steps. In the Final Office Action, at page 30, it noted that the reliance on Gimple follows from the rejection of claim 80. However, as discussed *supra*, Gimple fails to teach the claimed steps of claim 80. It is acknowledged in the Final Office Action that Gimple fails to show or suggest the delivery of a combined or sequential presentation of video and either one or more receiver specific data or one or more data described or promoted in said video. It is however asserted that it would have been obvious to one of ordinary skill in the art at the time of the invention to display sub-titles as suggested in Millar on the TV screen of the subscriber in Gimple since this would enable deaf viewers to better understand the video. Applicants' respectfully submit that this combination fails to render obvious the instant invention.

The combination of Gimple and Millar fails to show or suggest, *inter alia*, Applicants' claimed step of receiving at least one instruct signal at said transmitter station, said at least one instruct signal instructs said at least one receiver station to deliver one of a simultaneous presentation and a sequential presentation of said video and at least one of (i) at least one receiver specific datum and (ii) at least one datum that is at least one of described and promoted in said video. Gimple and Millar fail to show or suggest an instruct signal that instructs a receiver station to deliver a presentation of video and (i) a receiver specific datum or (ii) a datum that is described or promoted in said video. In the Final Office Action, it is noted that Gimple discusses displaying alphanumerics at the bottom of a television screen, but that the alphanumerics are not disclosed as related to video. It is then noted that Millar discusses the display of text and video simultaneously. Millar fails to show or suggest an instruct signal that instructs to deliver a receiver specific datum. Millar includes no suggestion that the text displayed is specific to the receiver. Millar fails to show or suggest an instruct signal that instructs to deliver a datum that is described or promoted in said video. Millar fails to show or suggest video describing or promoting a datum to be delivered. Any relationship between the text displayed and the video disclosed by Millar fails to show or suggest the specific relationship set forth by claim 84.

The combination of Gimple and Millar also fails to show or suggest, *inter alia*, Applicants' claimed steps of transferring said at least one instruct signal to said transmitter and transmitting said video and said at least one instruct signal to said at least one receiver station. As discussed above, neither Gimple nor Millar show or suggest an instruct signal as presently set forth. The applied references cannot, therefore, show or suggest transferring or transmitting such an instruct signal.

In the Final Office Action, the motivation for displaying the sub-titles as suggested by Millar on the TV screen of the subscriber in Gimple is to enable deaf viewers to better understand the video. As discussed above, the alphanumerics of Gimple are not displayed in association with any video from the television signals. Therefore, displaying sub-titles on the TV screen of the subscriber in Gimple involves a wholesale import of the system of Millar into the



system of Gimple. There is no motivation to modify the Gimple system in any way to include receiving at least one instruct signal as presently claimed.

Applicants respectfully request that the 35 U.S.C. §103(a) rejection of claim 84 be withdrawn.

**b. Dependent Claims 85-86**

Claims 85-86 depend upon independent claim 84. As discussed *supra*, Gimple et al. in view of Millar et al. fails to disclose every element of claim 84 and thus, *ipso facto*, Gimple et al. in view of Millar et al. fails to anticipate dependent claims 85-86, and therefore, this rejection should be withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**3. 35 U.S.C. § 103 (a) Rejection over Gimple et al., U.S. Patent No. 4,430,731 in view of Millar et al., British Patent Specification 1,370,535 and further in view of Lambert, U.S. Patent No. 4,381,522**

Claims 87 and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gimple et al., U.S. Patent No. 4,430,731 in view of Millar et al., British Patent Specification 1,370,535 further in view of Lambert, U.S. Patent No. 4,381,522.

Claims 87 and 88 depend upon independent claim 84. As discussed *supra*, Gimple et al. in view of Millar et al. fails to disclose every element of claim 84 and thus, *ipso facto*, Gimple et al. in view of Millar et al. and further in view of Lambert fails to anticipate dependent claims 87 and 88, and therefore, this rejection should be withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

**4. 35 U.S.C. § 103 (a) Rejection over Zaboklicki, DE 2904981 in view of "A Public Broadcaster's View of Teletext in the United States" by Hartford Gunn**

Claims 75-79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaboklicki in view of Gunn. Gunn discusses the possible advantages of broadcast teletext in the United States. Zaboklicki discusses in general terms (as best understood by Applicants) an "interactive television system" (i) wherein "a local central unit is provided in the home television receivers on the receiver side; that central unit switches the data selection systems on the basis of the television viewer's answer and on the basis of the centrally transmitted digital processing program for the television segments (transmission fragments)" (English language translation of DE 29 04 981 A 1 at page 10 lines 13 - 18); (ii) with "individual variants of ... additional information ... passed on in the form of acoustic or sound signals in the television receiver in the infrared band to the individual infrared receivers" (*id.* at page 11, lines 2 - 7); (iii) with "participation of the television viewer in the centrally transmitted telecast in such a way that the output signals of the local central unit in the viewfinder of the television camera turn on the contours of the person is provided for by the director [whereby the shape of the viewer contained in these contours is blended into the main content]" (*id.* at page 12, lines 8 - 13); and (iv) wherein, "[i]n the case of telecasts where an answer or the opinion of the television viewers is desired... the viewer's answer is put out parallel and converted into telephone signals... introduced into the subscriber telephone line... [and] supplied to the monitor in the television studio after statistical processing" (*id.* at page 12, line 13 - page 13, line 3).

In fact, Zaboklicki is so vague and indefinite in its description of the technology that virtually any reliance on the publication as prior art in the instant application can only be based on speculation and conjecture about the functionalities alleged to be provided by, or the method of operation of, the Zaboklicki system. Zaboklicki is not an enabling publication.

Applicants note the PTO has supplied and relies on a translation of German Patent publication No. DE 2904981 A 1 in formulating the rejections of the subject claims. Applicants have found that the applied German Patent publication is based on an earlier Polish patent

application No. PL 204525 A filed February 9, 1978. In addition to the German publication, the earlier Polish application also forms the basis for French patent publication FR 2417226 A published October 12, 1979 and British patent publication GB 2016874 A published September 26, 1979. Copies of the original Polish, and subsequent British, German and French patent publications are forwarded herewith.

After careful review of the Polish application and British publication, it is self evident that neither the translation provided by the PTO nor the British patent publication (presumably prepared or approved by Zaboklicki) indicates or suggests any method of operation of, or relationship between, the blocks shown in the various figures. In fact, it is difficult or impossible to determine what functions are being performed by the blocks shown in the various figures because many of the labels are not descriptive, failing to articulate or indicate the intended function. The written description does not cure this defect of the disclosure, failing to describe the functions or the interactions between the blocks. Examples of labels inadequately describing the structure of and function performed by the corresponding blocks are included in the following table.

Ref. No	Label	Description	
		English Language Translation of German Patent Publication	British Patent Publication
4	The circuit for the prescreening of information items for television viewers	preliminary screening of the information items for the television viewer	distributes the information for televiewers
5	The control circuit	none	output of control system 5 is additionally fed to the circuits 8 and 10 and is also applied to a circuit 11 for restoring the music signal
6	The central unit (the processor, for example, integrated microprocessor)	the output signals of the central unit 6 control a data selection circuit 8; energizes a sound signal switching unit 20 in at least one additional sound channel	output of circuit 3 is fed to a processor 6 ... [which] is also fed with signals representing the televiewer's answer from the circuit 2 [and] transmits a digital programme of manipulation, televiewers' answers and the successive identification data of ... individual fragments of the broadcast to a store or memory (RAM) 7; keyboard 12 feed into the processor 6 and the latter output to a transmitter of infra-red signals 13 which produces a remote control signal at 14; Digital data and audio signals with different variants of additional information are applied at 15 to the input of a receiver 16 of infra-red signals having an output in the form of digital data fed over line 17 to processor 6; switching-on of the selected audio channel as determined by the processor 6
10	The circuit for video signal conversion and image illumination	used to convert video signals and for image illumination	for converting video signals and displaying a picture
11	The circuit for sound signal restitution	circuit for sound signal restitution	for restoring
15	The digital data and the phonics with the different variants of additional information	none	input of receiver 16
19	The command for sound turn-on in the corresponding channel	command for a sound signal of a corresponding channel that is supplied to a circuit 20 for turning on the selected sound channel	commands to switch-on the audio signal from a specific channel are fed over the command line 19 from the processor 6 to the receiver 20
27	The switchover of the television channels for the prescreening of the corresponding fragments of a telecast	line for switching over television channels for preliminary screening of the corresponding fragments of a telecast	television receiver 54 is fed over line 53 with control signals from the remote control signal receiver 52 and over the one 27 from the output system 49 of the processor
28	The short term of call signal transmission during which the answer is delayed	control signal for the delay of the answer, which represent the short span of time during which call signal transmission takes place and during that time span, the answer is delayed.	[Control system 32] is also fed via 28 with a short delay signal for sending the dialing signals when the answer is postponed

Ref. No	Label	Description	
		English Language Translation of German Patent Publication	British Patent Publication
29	The prefix generator for transmission announcement of the television viewer's answer	for a transmission announcement of the television viewer's answer with a subscriber generator 30 and with a circuit 31 to generate the television viewer's answer	prefix generator for announcing the transmission of the televiewer's answer
35	The circuit for the introduction of the initial data of the television viewers	serves to put in initial data from the television viewers	circuit for introducing the televiewer's answers
36	The circuit for the prescreening of the digital data from the video signal	causes the preliminary screening of the digital data of the video signal	system for distributing the digital data from the video signals
38	The multiplexer circuit	supplies a signal for the subscriber telephone line 33.	Output from the units 29 and 30, 31 and 32 are applied to a multiplexer 38 whose output 46 is in turn fed to a subscriber telephone line
40	The circuit for the prescreening of the digital handling program (teleshware) and the identification data of the individual fragments of the telecast	for the prescreening of digital processing programs and the identification data of the individual transmission fragments with the input circuits 39	system for separation of the teleshware and the identification data of the individual fragments of the broadcast
41	The data selection circuit of the circuit for the comparison of the addresses of the teletext information items ....	constitutes a data selection circuit or a circuit for the comparison of the addresses of text information, for example, page numbers. Local central unit 6 switches over the data selection circuits 41 as a result of the answers from a television viewer and the digital processing programs which are supplied to the central unit 39 by the output circuit	information selections system or a system for comparing the address of the teletext information, for example the page number, in conjunction with the local processor 6 for switching over the information selection system depending upon the televiewers answer and on the teleshware
42	generator of the alphanumeric and graphic symbols	generator for alphanumeric and graphic symbols	alphanumeric and graphic character generator
43	circuit for turning on one of the additional sound channels in the television receiver (54)	switch-on or for the operation of additional sound channels of a television receiver 54	audio channel switch for switching on the sound signal in the television receiver
45	multiplexer circuit	multiplexer circuit	multiplexer of the receiver
46	signal output for the subscriber telephone line	none	none
47	circuit for the prescreening of the symbols for the control of the image illumination function	prefiltering or prescreening of the symbols for the control of image illumination	system for distributing characters to the display control
48	output circuit for symbols	output circuit	character output system

Ref. No	Label	Description	
		English Language Translation of German Patent Publication	British Patent Publication
51	multiplexer circuit in the viewfinder of the television camera for the application of the graphic symbols on the image	multiplexer circuit 51 in the viewfinder of a television camera is used to project the graphic symbols into the image of receiver 54 of the television camera that furthermore is connected to a receiver 52 for a remote-control signal	multiplexer system
54	television receiver with at least one additional sound channel	receiver	television receiver including an audio channel switch 43 for switching on the sound signal I the television receive and an output circuit 55 for the video signal
56	teletext decoder with the additional data output after hamming decoder	a video text decoder 56 with an additional data output (hamming decoder)	teletex decoder having an additional data output behind the Hamming decoder comprising a control system 26, a system 36 for distributing the digital data from the video signals, a system 40 for separation of the telesoftware and the identification data of the individual fragments of the broadcast, an information selection system 41, (or a system for comparing the address of the teletex information, for example the page number, in conjunction with the local processor 6 for switching over the information selection system depending upon the viewers answer and upon the telesoftware), an RAM memory 44, a system 57 for distributing control characters, (for example no display), an alphanumeric and graphic character generator 42, a system 47 for distributing characters to the display control and a character output system 48.
57	circuit for the prescreening of the control symbols, for example, a command: do not illuminate	A circuit 57 in decoder 56 is used for the prefiltering of control signals or control commands (For example, do not illuminate.)	system for distributing control characters, (for example no display)

It is established that prior art must be enabling. *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 1365, 27 U.S.P.Q.2d 1027 (Fed. Cir. 1998). "In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method." *Beckman Industries, Inc. v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989) (citing *In re Payne*, 606 F.2d 303, 314, 203 USPQ 245, 255 (CCPA 1979)). Accordingly, in *Beckman*, held as a correct statement of the law were jury

instructions that stated, "References relied upon to support a rejection for obviousness must provide an enabling disclosure. That is to say, they must place the claimed invention in the possession of the public." *Id.* at 1550-51, 13 USPQ2d at 1303-4. The Federal Circuit has observed that "even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling." *In re Donohue*, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985) (citing *In re Borst*, 345 F.2d 851, 855, 145 USPQ 554, 557 (CCPA 1965), cert. denied, 382 U.S. 973, 148 USPQ 771 (1966) ("the disclosure must be such as will give possession of the invention to the person of ordinary skill")). See also *In re Epstein*, 32 F.3d 1559, 1568, 31 USPQ2d 1817, 1823 (Fed. Cir. 1994); *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 651-52, 223 USPQ 1168, 1173 (Fed. Cir. 1984); *Preemption Devices, Inc. v. Minnesota Mining & Manufacturing Co.*, 732 F.2d 903, 906, 221 USPQ 841, 843 (Fed. Cir. 1984).

If anything is clear, it is that Zaboklicki does not place the technology of applicants' invention into the hands of the public. The primary reference to Zaboklicki at most presents some block diagrams which, as best understood, are directed to the four functions previously outlined. The details of these functionalities or how they are accomplished are not described in sufficient detail or with sufficient clarity to constitute an enabling disclosure. The secondary reference to Gunn fails in any way to cure this deficiency of the Zaboklicki reference. Accordingly, the rejection of the claims under § 103 as being unpatentable over Zaboklicki in view of Gunn are improper and withdrawal thereof is respectfully requested.

Additionally, Applicants respectfully submit the reference entitled "A Public Broadcaster's View of Teletext in the United States" by Hartford Gunn et al. is not prior art under 35 U.S.C. § 103. This reference includes no indication whatsoever that it was in existence prior to November 3, 1981, which is the effective filing date of claims 75-79. Applicants', accordingly, respectfully request that the rejections of the claims under § 103 as being unpatentable over Zaboklicki in view of Gunn are improper and withdrawal thereof is respectfully requested.

Assuming *arguendo*, that the combination of Zaboklicki in view of Gunn is available as prior art under 35 U.S.C. § 103, Applicants submit that the applied references fail to render obvious the presently claimed invention. Applicants accordingly provide the following arguments that the claimed invention is patentably distinguishable from the Zaboklicki system modified in view the teaching of Gunn.

**a. Independent Claim 75**

With respect to Applicants' claim 75, Zaboklicki in view of Gunn fails to, *inter alia*, teach or suggest receiving said at least one control signal at said transmitter station, said at least one control signal being operative at said at least one receiver station to control one of (i) an execution of said downloadable processor instructions and (ii) a delivery of at least a portion of said video presentation. In the Final Office Action, it is acknowledged that Zaboklicki does not disclose control signal as presently claimed. However, it is asserted that Gunn teaches providing a teletext activation signal for activating or executing software. Notwithstanding this assertion, Gunn fails to teach such a signal. Gunn merely describes in general terms a foreseeable teletext system. Gunn provides no details as to what signals are used or required to provide the foreseen interactive teletext display. Gunn merely discloses that interaction is accomplished through software downloaded at the user end. Gunn fails to disclose the details of the operation or control of such software. There is no suggestion that a control signal is received that is operative to control an execution of downloadable processor instructions or a delivery of at least a portion of a video presentation.

Zaboklicki as modified by Gunn also fails to show or suggest Applicants' claimed step of receiving at a transmitter station said downloadable processor instructions, wherein said downloadable processor instructions instruct said at least one receiver station to one of generate and output a specific portion of said video presentation, said downloadable processor instructions having at said at least one receiver station a target processor to process data. In the Final Office Action, at pages 31-32, the digital processing program referred to in Zaboklicki is relied upon to show the downloadable processor instructions presently set forth. It is asserted that the



downloaded digital processing program is effective to output a specific portion of video. However, the present claim sets forth a video presentation including (a) a first video image and (b) a second video image, said second video image (i) containing at least one datum that at least one of completes and supplements said first video image and (ii) overlaying said first video image. Zaboklicki merely discloses, "that central unit switches the data selection systems on the basis of the television viewer's answer and on the basis of the centrally transmitted digital processing program for the television segments." There is no suggestion of a video presentation with a second image that includes a datum that completes or supplements a first image or that overlays a first image. Zaboklicki, thus, fails to suggest instructing a receiver station to generate or output a specific portion of such a video presentation. There is no suggestion that the secondary reference to Gunn cures this deficiency of the primary reference to Zaboklicki.

Accordingly, Zaboklicki as modified by Gunn fails to show or suggest, *inter alia*, Applicants' claimed step of transmitting an information transmission comprising said downloadable processor instructions and said at least one control signal. As discussed above, neither Zaboklicki nor Gunn show or suggest receiving downloadable processor instructions or receiving a control signal as presently set forth. The applied references, therefore, cannot show or suggest an information transmission comprising both said downloadable processor instructions and said at least one control signal. Thus, Zaboklicki as modified by Gunn must fail to show or suggest transmitting such an information transmission.

Likewise, as the applied references fails to show or suggest a control signal as presently set forth, the references cannot show or suggest transferring said at least one control signal to said transmitter as presently claimed.

In the Final Office Action, it is asserted that it would have been obvious to modify the system of Zaboklicki to send a teletext activation signal as taught by Gunn. There is no support found in the prior art for this assertion. Gunn fails to teach a control signal as presently claimed. Accordingly, there is no motivation or suggestion in Gunn that such a control signal would be advantageous or useful in the process of Zaboklicki. Likewise, there is motivation or suggestion

found in Zaboklicki that the disclosed process would be improved if modified to include a teletext activation signal as suggested in the Final Office Action. There is no objective teaching in the prior art that would have led one to combine the teachings of the applied references as suggested in the Final Office Action.

Applicants respectfully submit that the combination of Zaboklicki in view of Gunn fails to render obvious claim 75 for the above reasons. Accordingly, Applicants' respectfully request that the 35 U.S.C. §103(a) rejection of claim 75 be withdrawn.

**b. Dependent Claims 76-79**

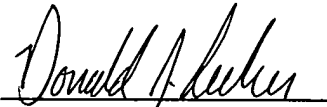
Claims 76-79 depend upon independent claim 75. As discussed *supra*, Zaboklicki in view of Gunn fails to disclose every element of claim 75 and thus, *ipso facto*, Zaboklicki in view of Gunn fails to anticipate dependent claims 76-79, and therefore, this rejection should be withdrawn and the claims be permitted to issue. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

### III. CONCLUSION

In accordance with the foregoing it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. Further, all pending claims are patentably distinguishable over the prior art of record, taken in any proper combination. Thus, there being no further outstanding objections or rejections, the application is submitted as being in a condition for allowance, which action is earnestly solicited.

If the Examiner has any remaining informalities to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such informalities.

Respectfully submitted,



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Serial No. 08/470,571  
Docket No. 5634.0261

## **APPENDIX A**

## **APPENDIX A**

The following foreign reference has been cited by Applicants in the Information disclosure Statements filed 12-11-95, 12-22-95, 2-6-96, 4-17-96 and 4-7-97. Applicants have further included the following relevancy statement as well as an English abstract (in the case of foreign patents), thus meeting the requirements as set forth in 37 CFR 1.98 and MPEP § 609.

### **For the Information Disclosure Statement filed 12-22-95:**

**23 38 330      February 13, 1975      Germany**

This reference discloses television receivers that transmit control signals to a decoder/processor combination.

### **For the Information Disclosure Statement filed 2-6-96:**

**61-050470      March 12, 1986      Japan**

This reference discloses a program engagement device that displays the program content at a television receiver and includes a display output control device.

**60-61935      April 9, 1985      Japan**

This reference discloses a system that generates, detects, communicates, and/or converts digital signals.

### **For the Information Disclosure Statement filed 4-17-96:**

**2 058 681      June 15, 1972      Germany**

This reference discloses a television mode arrangement for transmitting, receiving, and presenting coded information.

**For the Information Disclosure Statement filed 4-7-97:**

**0 020 242      December 10, 1980      European**

This reference discloses a teletext character alignment process.

**0 046 108      February 17, 1982      European**

This reference discloses a integrated circuit interface between a television receiver and recorder.

**0 049 184      April 7, 1982      European**

This reference discloses a pocket teaching aid using a television receiver with a teletext system.

**0 055 167      June 30, 1982      European**

This reference discloses a teletext CRT display for messages from a composite memory.

**0 077 712      April 27, 1983      European**

This reference discloses a multi-channel digital packet television broadcasting system.

**0 078 185      May 4, 1983      European**

This reference discloses a digital packet broadcasting system using television transmissions.

**2 496 376      June 18, 1982      France**

This reference discloses a teletext display of data on the television screen.

**2 516 733      May 5, 1983                      France**

This reference discloses an error controller for a teletext television decoder.

**2 823 175      November 29, 1989                      Germany**

This reference discloses a teletext information display for television transmission.

**24 53 441      May 13, 1976                              Germany**

This reference discloses a wideband signal transmission with digital to image signal conversion.

**DE 30339949   May 6, 1982                      Germany**

This reference discloses a method for the generation of teletext display having a color character contrast.

**DE 3112249    October 7, 1982                      Germany**

This reference discloses a processing signals from either a colored television receiver or from a video text decoder.

**DE 3020787    December 17, 1981                      Germany**

This reference discloses a television transmission system that sends extra data during a blanking period.

**WO 80/00292   February 21, 1980                      Japan**

This reference discloses a decoder for a television receiver that has a color component that splits signals and recombines the signals into a composite drive current signal.

**WO 83/00789 March 3, 1983      Japan**

This reference discloses an image display unit which displays received image signals via a memory, wherein the image signals include teletext displays of weather reports or television programs.

**Graf, P.H., "Antiope-Uebertragung fuer Breitbandige Videotex-Verteildienste," 1981.**

This reference shows an Antiope demodulator/detector.

**Heller, Arthur, "VPS - Ein Neues System Zuragsgesteuerten Programmanfezeichnung, Rundfunk technisde Mitteilungen, pp. 162-169.**

This reference discloses a decoding system for use with a VCR.

**Marti, B et al., Discrete, service de television cryptee, Revue de radiodiffusion - television (1975), pp. 24-30.**

This reference discloses an analog decryption system.

**Strauch, D., "(Las Media De Telecommunication Devant la Rapture. Les Nonvellas Methodes Presentees a L'Eposition International 1979 de Radio (Et Television)) 1979.**

This reference is a discussion of videotext, teletext, ceefax, oracle, and antiope.